

REMARKS

This Reply is in response to the Non-final Office Action dated June 22, 2009, in which the Examiner rejected claims 1 – 6 under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent 2,932,091 (“Day”). Claims 7 – 8 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Day in view of U.S. Patent No. 4,417,661. Additionally, the Non-final Office Action included a restriction requirement between claims 1 – 8 (Group I) and claims 9 – 14 (Group II). Claims 1 – 14 remain pending. Reconsideration is respectfully requested in light of the amendments and remarks herein.

I. Restriction Requirement

In response to the Restriction Requirement in the Office Action, Applicants elect, with traverse, Group I (claims 1 – 8). Applicants confirm the non-election of Group 2 (claims 9 – 14). However, for the reasons set forth below, Applicants traverse the Restriction Requirement on the grounds that the Examiner has not provided sufficient evidence to establish that the claims of Group I are distinct from the claims of Group II. Nor has the Examiner provided sufficient evidence that there would be an examination and search burden because the species require a different field of search and/or applicable prior art applicable.

Restriction is proper only when the claims are distinct and there would be a serious burden to search and examine the claims in a single application. The criteria for establishing distinctness are set forth in M.P.E.P. § 806.05(c), which states that:

[t]he inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in another materially different combination.

As described below, Applicant submit that the Examiner has not established either of these two criteria. With respect to criteria (A) – that the claims of one of the groups do not require the particulars of the claims of the other group for purposes of patentability – the Office Action does not seem to contain any supporting rationale, but rather appears to only include a statement directed to criteria (B).

The only support provided by the examiner is that the “subcombination of group I has separate utility such as longitudinal pipes fixedly connected to a support structure.” (Office Action, page 2). However, Group II correspondingly recites “a first support structure rigidly connected to and supporting the first set of longitudinal pipes.” It is unclear how these subcombinations could be deemed distinct and nonobvious variants, let alone having separate utility since what is recited are longitudinal pipes fixedly connected to a support structure, on the one hand, and a support structure that is rigidly connected to and supporting a set of longitudinal pipes, on the other hand. In short, A + B is not distinct from B + A. Moreover, the fact that the support structure and longitudinal pipes are recited as being *fixedly* connected in Group I versus *rigidly* connected in Group II is clearly insufficient to show distinctiveness. Similarly, the fact that the “support structure” in Group II is expressly recited as supporting the longitudinal pipes similarly does not create distinctiveness as it would be obvious to anyone that a support structure would perform a supporting function.

Furthermore, there is no showing in the Restriction Requirement that the invention of Group I has a separate utility from that of the invention of Group II. For example, even if “*fixedly attached*” were nonobviously distinct from “*rigidly attached*,” there is no showing as to how this would impart separate utility.

Therefore, with respect to the claims of Group I and Group II, Applicants submit that the Examiner has not established either criteria (A) nor criteria (B) set forth above for showing distinctiveness.

The Restriction Requirement claims that there is an examination and search burden because the species require a different field of search and/or prior art applicable to one species would not likely be applicable to another species. However, as discussed in M.P.E.P. § 803, to support the Restriction Requirement, “Examiners **must** provide reasons and/or examples to support conclusions.” M.P.E.P. § 803 II (*emphasis added*). Accordingly, “For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown ** by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.” M.P.E.P. § 803 II.

The Restriction Requirement identifies a separate subclass, but fails to explain why separate subclasses are necessary. Thus, the Patent Office has not provided an “appropriate explanation of separate classification.” The Restriction Requirement also does not include an “explanation of . . . separate status in the art, or a different field of search.” Because the Restriction Requirement has not provided any reasons or examples to support the conclusion that there would be a serious burden if restriction was not required, the Patent Office has not satisfied one of the basic criteria for a proper restriction requirement, and this Restriction Requirement is therefore improper and should be withdrawn.

For at least the aforementioned reasons, Applicants traverse the Restriction Requirement and respectfully request that it be withdrawn.

II. Rejection of Claims 1 – 6

In the Office Action, the Examiner contends that claims 1 – 6 are anticipated by Day. However, Applicants submit that Day suffers from numerous deficiencies, some of which are identified below.

Applicants first note that, in Day, the material to be dried is positioned over the external surface of the drum (“the drying of the web of paper passing over the external surface of the drum as in the drying end of a paper-making machine.” Day, col. 1, ll. 15 – 20). In contrast, claim 1 expressly recites “material to be dried is fed to a first end of the drying apparatus, the material being arranged to be discharged through a second end of the drying apparatus.” Day provides no teaching or suggestion for this arrangement as it is designed to dry material “passing *over* the external surface of the drum” rather than *through* the drum. There is no disclosed structure which would even be capable of passing the material to be dried through Day’s roll/shell **13** as tube **14** must be used to carry steam in order for the invention of Day to function.

In the Office Action, the Examiner has erroneously equated the recited “heat transfer element” with the “circular header tube **17** joined to the inner periphery of one end of the roll.” (Day, Col., 4, 14 – 16). However, the “heat transfer element” of claim 1 is not recited as being merely any heat transfer element. Rather, the “heat transfer element” is expressly and specifically recited as included each of the (1) “support structure,” (2) “longitudinal pipes,” and (3) “connecting pipes.” As such, there is no reasonable reading of Day that the circular header tube **17** equates with the recited “heat transfer element,” including the embodiment of Day in which “the steam header **17** is positioned intermediate the ends of the roll” In particular, neither the function nor the structure of the disclosed steam header **17** in Day could satisfy each of the claimed limitations corresponding to the recited “heat transfer element.”

Applicants further note that Day fails to teach or suggest attaching longitudinal pipes fixedly to a support structure, and then attaching the support structure to the drum using fastening that allows for heat expansion, as recited in claim 1. Day is clear that the “plurality of disc-like frames 23 . . . have their outer edges bonded with the shell 13.” (Day, col. 4, ll. 62 – 64), which is exactly the kind of

deficiency in the prior art to which at least some aspects of the present invention are directed. In particular, the “abrading place in the drying apparatus is not an individual pipe but a support structure of the heat transfer element packet, connecting the drum frame with fastening that allows heat expansion,” as expressly noted in the pending application. See Specification, ¶ [0007].

Additionally, Applicants note that tubes **22** of Day “are bonded in good heat-conducting relation to the roll body **13**, preferably by welded joints.” Col. 4, ll. 20 – 21 (*emphasis added*). This arrangement is in direct contradiction and in fact teaches away from the recited arrangement of claim 1 in which the longitudinal pipes are fixedly connected to a support structure, and then the support structure is attached to the drum using fastening that allows for heat expansion. Thus, the tubes **22** in Day can not reasonably be equated with the recited longitudinal tubes. The same deficiency exists with respect to Day’s disc-like frames **23**.

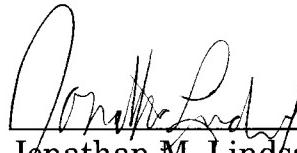
Additionally, the examiner is equating roll **13** of Day with the recited support structure. See Office Action, page 6. However, Day is clear that the roll **13** is the drum itself. Day even repeatedly refers to element **13** as being the shell **13**. See e.g., Day, col. 4, line 23, 31 & 70. However, claim 1 recites that the “heat transfer element” is “rotated within and with the drum,” and that this same “heat transfer element comprises a support structure” Perhaps more importantly, the support structure of claim 1 is recited as being “attached to the drum.” Thus, the recited “support structure” must be distinct from and within the drum, and cannot reasonably be interpreted as being the drum or shell itself.

For the reasons set forth above, Applicants submit that Day fails to anticipate or render obvious the pending independent claims. Additionally, the dependent claims are allowable at least by virtue of their dependency on allowable base claims. Thus, all pending claims are now in condition for allowance and early action is respectfully requested. If there are any questions regarding this response

or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned. No additional fees are believed due for this Reply. However, in the event a fee is required, the Commissioner is hereby authorized to charge such fee to Deposit Account No. 05-1323 (Ref. # 101908.56491US).

Respectfully submitted,

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